PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shunsuke NAGATANI et al.

Group Art Unit: 2624

Application No.: 10/661,590

Examiner: S. MOTSINGER

Filed: September 15, 2003

Docket No.: 117146

For: IMAGE RETRIEVAL SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the August 28, 2009 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Date: November 30, 2009

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REMARKS

Claims 1, 4, 6 and 9-11 are pending in this application. The Office Action, on page 3, rejects claims 1, 4, 6 and 9-11 under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed.

The Office Action alleges that there is no support in the specification for a "second extraction," or the element "a first extraction performed by the first extraction unit and a second extraction performed by the second extraction unit." Specifically, the Office Action asserts that the elements 12 and 14 illustrated in Fig. 3, are not found in the specification to describe a first and second extraction unit.

This assertion is unreasonable because one of ordinary skill would have understood that elements 12 and 14 correspond to the recited first and second extraction units. 35 U.S.C. §112, first paragraph, does not require that the specification have verbatim language corresponding to the recited claim language. Accordingly, it is unreasonable for the Office Action to assert that there is no support in the specification for the recited second extraction unit.

The Office Action also rejects claims 4 and 10 under 35 U.S.C. §112, first paragraph. This rejection is respectfully traversed.

The Office Action asserts that, while the specification admittedly enables the recited processor, the specification does not provide enablement for every conceivable processor for performing the claimed method. The Examiner's assertion in this regard is unreasonable and unfounded. There is no basis for the Examiner to assert that an application must disclose every conceivable variation of a processor to support such a feature recited in the claims.

The Office Action rejects claims 1, 4, 6 and 9-11 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

The Office Action asserts that the recited first extraction performed by the first extraction unit and a second extraction performed by the second extraction unit being instructed by the user on a same screen does not make any sense in the context of the specification. Specifically, the Office Action asserts that the term "a same screen" is unclear.

The Office Action is unreasonable in this rejection because, as argued in the May 27, 2009 Amendment, Fig. 3 illustrates a user interface screen with a first keyword input part 12 and a second keyword input part 14 that are both accessible by a user on the same screen. A first extraction performance by the first extraction unit and a second extraction performance by the second extraction unit being instructed by a user on a same screen is clearly depicted in Fig. 3.

The Office Action also asserts that claim 4 is not an apparatus claim because it contains no structural elements and only method steps. This assertion is unreasonable because claim 4 is clearly directed to a processor that performs an image retrieval method.

Accordingly, reconsideration and withdrawal of the rejections of claims 1, 4, 6 and 9-11 under 35 U.S.C. §112, first and second paragraphs, are respectfully requested.

The Office Action rejects claims 1, 4, 6 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,281 to Chen et al. (hereinafter "Chen") in view of U.S. Patent No. 6,789,228 to Merril et al. (hereinafter "Merril"). This rejection of the Office Action is respectfully traversed.

The Office Action asserts that Chen teaches many of the features recited in at least independent claims 1, 4 and 6. The Office Action concedes that Chen fails to explicitly disclose extracting a character string contained in the static image data by at least one of (1) extracting text from the static image data which has the text data and (2) performing character recognition processing on the static image data and extracting text data which is a result of

the processing. The Office Action relies on Merril, in its disclosure of a method and system for the storage and retrieval of web-based educational materials, to make up for this shortfall.

Merril is directed to a system that automatically digitally captures lecture presentation slides and speech, and stores the data in memory. The Office Action alleges that Merril teaches a second extraction unit that extracts the keyword input by the user from at least one of meta-data and voice index data. The Office Action asserts that it would have been obvious to have combined Merril with Chen to allow searching of voice data and text data. This analysis of the Office Action fails for at least the following reasons.

The Office Action asserts that Merril, at col. 10, lines 30-50 and Fig. 9, teaches features that would have suggested the recited first extraction performed by the first extraction unit and a second extraction performed by the second extraction unit being instructed by the user on a same screen. Merril allegedly teaches a front-end interface 900 that has a fourth frame that contains a box in which the user can enter search terms 912, a pop-up menu with which the user can select types of media the user wishes to search, and a button that initiates the search. Fig. 9 of Merril shows that in a search box 912, (in the lower right-hand corner) below the words "Search In" there is a dropdown box which, in this example, the user has selected "Audio Transcript."

But Merril cannot be reasonably considered to have suggested that more than one type of media can be selected for the search. For instance, based on the pop-up menu/dropdown box described and shown in Fig. 9, there is nothing to suggest that the user may select searching both the text box and the audio transcript. Rather, the pop-up menu/dropdown box illustrated in Merril is of the type that may select only one type of selection at a time. Merril also only discloses one input box, as opposed to both the recited first and second extraction units. That is Merril only illustrates a single search field 912. Therefore, Merril cannot reasonably be considered to have suggested a first extraction performed by the first extraction

unit and a second extraction performed by the second extraction unit being instructed by the user on a same screen, as recited in independent claims 1, 4 and 6. Such would require there to be two input fields, whereas, in Fig. 9 of Merril, there is only one.

For at least the foregoing reason, and because Chen fails to make up for the above-identified shortfall in Merril, no combination of Merril with Chen would have suggested the combinations of all of the features recited in independent claims 1, 4 and 6. Further, dependent claims 9-11 would also not have been suggested by any combination of the currently-applied references for at least the dependence of these claims on independent claims 1, 4 and 6, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 4, 6 and 9-11 under 35 U.S.C. §103(a) over Chen in view of Merril, are respectfully requested.

Applicant respectfully submits that the Panel specifically review the totality of Applicant's arguments, and the totality of the assertions made in the Office Action. Applicant believes that upon such review, the Review Panel will determine that the applicable standards for attempting to render obvious the subject matter of the pending claims over the asserted combination of applied references have now been met.